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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/340,218 | 06/25/1999 | GEORGE G. CHADWICK | MGC9901 | 3626 |

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INTELLECTUAL PROPERTY LAW OFFICE
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CAMPBELL, CA 95008

EXAMINER

WEST, LEWIS G

ART UNIT PAPER NUMBER

2682

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/340,218

Applicant(s)

CHADWICK, GEORGE G.

Examiner

Lewis G. West

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments filed August 19, 2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claim 16, 18 and 19 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., communications using a quasi-static non-propagating field) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant does not claim that the electromagnetic field is being used for communication. The only thing claimed by applicant is that a quasi-static non-propagating field is generated in a communications system, (in claim 14, whereas claim 18 has no limitations regarding any kind of communication).

In response to applicant's arguments, the recitation electromagnetic field communications has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, although applicant's preamble establishes a communication system as the environment of the device, applicant only claims

"means for generating a quasi-static non-propagating electromagnetic field within said structure", so in no way has applicant claimed a way in which the field is being used to communicate anything, only that the field is produced. The "means for generating" limitation is able to stand alone.

Further regarding the limitation "suitable for use with wireless communication devices" in claim 14, and further limited in claim 17, the examiner cited Column 4 lines 1-3 of Hershey, which contrary to applicant's argument is not cited to establish EMF communication within the building, but that the communications system of Hershey is used with a radio, as alternatively claimed by applicant. Hershey states, "...the collected data is then transmitted, e.g., via radio to a central station". Hence the communication system of Hershey is not only suitable for use with wireless communication devices, but is clearly disclosed as being used with a wireless communication device, which is a radio.

Regarding arguments with respect to the term "selected", a frequency and size had to have been "selected" in Hershey, the result of this selection being that the dimension of the grid opening size is small relative to the wavelength of said frequency signal. Arguments that no selection was made are unpersuasive; because if no selection was made the system could never be completed. The resulting system exhibits the stated property that occurred as a result of said selection. Therefore Hershey clearly discloses a system wherein the frequency of said frequency signal is selected such that the dimension of the grid opening size is small relative to the wavelength of said frequency signal.

Applicant then agrees that the grid limitation is clearly in Hershey but is not relevant and therefore there is no obviousness. Given that no obviousness rejection has been made, this is

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irrelevant. Under 35 USC 102, if the limitation is clearly taught in the prior art, then it is anticipated.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Telewski (US 6,021,315).

Regarding claim 14, Hershey discloses an electromagnetic field communication system, suitable for use with wireless communication devices comprising: a structure including an electrically conductive grid array having a grid opening size (building frame 10); and means for generating a quasi-static non-propagating electromagnetic field within said structure by feeding a frequency signal into said electrically conductive grid array (Col. 3 lines 40-57); wherein the frequency of said frequency signal is selected such that the dimension of the grid opening size is small relative to the wavelength of said frequency signal. (Col. 4 lines 17-30)

Regarding claim 15, Hershey discloses a communication system wherein the frequency of said frequency signal is selected such that the wavelength is greater than twice the dimension of the grid opening size. (Col. 4 lines 17-30)

Regarding claim 17, Hershey discloses the electromagnetic field communications system of claim 14 wherein said wireless communications devices are radios. (Col. 4 lines 1-3)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hershey in view of Richley (US 5,437,057).

Regarding claim 16, Hershey discloses the electromagnetic field communications system of claim 14, (Col. 4 lines 17-30). Hershey does not use radio frequencies in communication. Richley discloses an intra building communication system to communication using near field within a building at a frequency range of 100-400 MHz. (Col. 5 line 54- Col. 6 line 19) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a frequency signal is in the range of 3 to 400 Megahertz in an electromagnetic field communications system, because of the advantageous properties at higher frequencies such as less susceptibility to interference, and motivation lies in Iwata to use said frequency range as suitable for a buildings attenuation requirements.

Regarding claim 18, Hershey discloses an electromagnetic field system, comprising: a structure including an electrically conducting grid array having a grid opening size; an electromagnetic field generator for generating a quasi-static electromagnetic field within said

structure by feeding a frequency signal into said electrically conductive grid array; and wherein said grid opening size is small relative to the wavelength of said frequency signal. (Col. 4 lines 17-30) Hershey does not use radio frequencies in communication. Richley discloses an intra building communication system to communication using near filed within a building at a frequency range of 100-400 MHz. (Col. 5 line 54- Col. 6 line 19) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a frequency signal is in the range of 3 to 400 Megahertz in an electromagnetic field communications system, because of the advantageous properties at higher frequencies such as less susceptibility to interference, and motivation lies in Iwata to use said frequency range as suitable for a buildings attenuation requirements.

Regarding claim 19, the combination of Hershey and Richley discloses the electromagnetic field system of claim 18, wherein the dimension of said grid opening is less than one half the wavelength of the frequency signal. (Col. 4 lines 17-30)

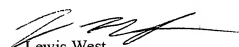
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 571-272-7859. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quochien B. Vuong can be reached on 571-272-7902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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